



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,969	04/25/2006	Thomas Wegmann	P/3610-66	7580
2352 7590 12/11/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER PRYOR, ALTON NATHANIEL	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/576,969	WEGMANN ET AL.	
	Examiner	Art Unit	
	Alton N. Pryor	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-19 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/25/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 16 are incomplete in that the claim does not make a fungicidal compound (c) clear.

Claims 14 and 15 recite the limitation "the additional fungicidal" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercer et al (WO 03/034824; 5/1/03) and The Agrochemicals Handbook, 3rd edition, A0400, August 1991. Mercer et al teach a fungicidal composition comprising a compound of instant formula I where R1 can be selected from hydrogen, optionally substituted alkyl or optionally substituted acryl and R3 and R4 can be selected from

halogen, hydroxyl, cyano, nitro, -SF₅, trialkylsilyl, optionally substituted amino, acyl, or E, OE or SE. See abstract, pages 5-6, Mercer teaches that the composition can comprise phosphorous acid derivatives such as fosetyl - Al which is aluminum ethyl hydrogen phosphonate as well as carriers. See page 14 line 26 and page 15 lines 9-15. Mercer teaches a method of applying the composition onto seed and vine plants in order to control fungi growth. See page 16 lines 7-8 and page 24 lines 23-28. Mercer does not teach the composition / method comprising tolylfluanid. However, The Agrochemicals Handbook discloses that tolylfluanid is a fungicide. It would have been obvious to modify the composition / method of Mercer to include the tolylfluanid taught by The Agrochemical Handbook. One would have been motivated to do this since Mercer is open to the inclusion of other fungicides. See Mercer page 14 lines 1-2. With respect to the amounts and ratios of ingredients, one having ordinary skill would have determined the optimum amounts and ratios of ingredients. One would have been motivated to do this in order to develop an invention that would have been most effective in controlling fungi. It is possible that the optimum amounts / ratios of ingredients determined for the instant invention could have fallen within the instant ratios and amounts. The specification provides unexpected (synergistic) results for the composition / method comprising a compound of formula Ia, i.e, 2,6-dichloro-N-[[3-chloro-(trifluoromethyl)-2-pyridyl]methyl]benzamide and tolylfluanid. However, the claims are not commensurate in scope with the unexpected results. For e.g. when R₁ is acyl and R₃ and R₄ are heterocycyl as opposed to simple electron withdrawing / donating groups such as halogen, simple electron donating groups such as halogen and

simple electron withdrawing groups such as haloalkyl (see instant compound Ia).

Halogens and haloalkyls differ vastly from acyl and heterocycyl I in size and electronic properties and therefore the activity provided by a simple halogen and / or haloalkyl could not be extrapolated to predict the activity of more complicated structures such as acyls and heterocycyl due to their size and electronic properties.

Claim Objection

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The specification provides synergistic results for the composition comprising a compound of Ia and tolylfluorid. Compound Ib and Ic like Ia have simple electron withdrawing and donating groups such as halogen and simple electron withdrawing groups such as haloalkyl and nitro for R3 and R4. For this reason, one having ordinary skill in the art would expect for the activity of nitro compound to be similar to the activity provided by the halogen and haloalkyl compound of formula Ia.

Telephonic Inquiry

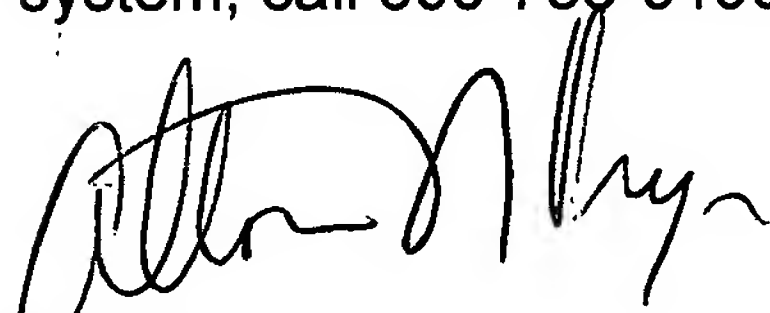
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/576,969
Art Unit: 1616

Page 5

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Alton Pryor', is written over the printed name.

Alton Pryor
Primary Examiner
AU 1616